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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,906	06/15/2001	David K. Hood	FDN-2660/B	8877

7590

07/07/2003

Att: William J. Davis, Esq.
INTERNATIONAL SPECIALTY PRODUCTS
Legal Department, Building No. 10
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EXAMINER

YOON, TAE H

ART UNIT PAPER NUMBER

1714

DATE MAILED: 07/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/H01.906

Applicant(s)

Hood et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3, 4, and 6-12 is/are rejected.
- ☒ Claim(s) 2 and 5 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is a hybrid format, process and product, which is indefinite. Claims 10 and 12 recite a product-by-process, but claim 1 already recites a product. The recited "PETE" and "PETA" in claim 8 is indefinite and full spellings are needed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Geyer et al (US 4,866,148).

Geyer et al teach crosslinked copolymers of N-vinyl pyrrolidone in abstract and examples. Said copolymers are in the form of an interpenetrating network (IPN, col. 4, lines 26-29) which is a two-phase system inherently. An invention in a product-by-process claim is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Since the PTO does not have equipments to conduct the test, it is fair to require applicant to shoulder the burden of proving that his hydrogels differ from those of Geyer et al. *In re Best*, 195 USPQ 430,433 (CCPA 1977).

Thus, the instant product lacks novelty.

Claims 1 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Munro et al (US 2002/0037270).

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Munro et al teach a crosslinked interpenetrating network copolymer in [0049] to [0056] and examples. A coating of said copolymer on a film is taught in [0067], and said copolymer is a water-resistant inherently absent a particular property.

Thus, the instant product lacks novelty.

Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ogawa et al (US 4,600,641 or 4,699,705).

Ogawa et al (US'641) teach crosslinked copolymers and coating thereof on a polyester sheet at col. 14, line 43 to col. 15, line 32 and in example 1. Ogawa et al (US'705) teach the same in abstract and example 1. Thus, the instant product lacks novelty.

Claims 1 and 12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yanase et al (US 6,187,872).

Yanase et al teach an internally and externally crosslinked copolymer in example 1. Various water soluble monomers are taught at col. 6, lines 2-45.

Thus, the instant product lacks novelty.

Claims 1, 3, 4, 6-9 and 12 are rejected under 35 U.S.C. 103(a) as obvious over Yanase et al (US 6,187,872) in view of Fan et al (US 4,618,647) or Ogawa et al (US 4,600,641).

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Yanase et al teach the instant process in example 1 except the additional initiator in example 1. The instant crosslinkers such as pentaerythritol tetraacrylate (col. 6, lines 65-66) and pentaerythritol triallylether (col. 7, lines 32-33) are also taught. However, the use of a sequential addition of initiators in order to improve the reaction is well known as taught by Fan et al (col. 7, line 29 col. 10, line 41) and Ogawa et al (Synthesis Examples 5 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the sequential addition of initiators taught by Fan et al or Ogawa et al in Yanase et al since Yanase et al teach the use of any known polymerization method at col. 7, line 65 to col. 8, line 2 and since the use of said sequential addition of initiators in order to improve the reaction is well known in the art.

Claims 2 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action since a process of coating onto a polyester film and the addition of proteinaceous compound would not be obvious in view of the cited prior art.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat. 6,303,281 to Wang et al teach the use of a crosslinked gelatin in a part of UV absorbing layer of a photographic element at col. 6, lines 41-60.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/June 30, 2003


TAE H. YOON
PRIMARY EXAMINER